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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/584,318	05/31/2000	Alok Srivastava	A-011	2234
21253	7590	08/23/2005	EXAMINER	
CHARLES G. CALL 68 HORSE POND ROAD WEST YARMOUTH, MA 02673-2516			NGUYEN, CHAU T	
			ART UNIT	PAPER NUMBER
			2176	

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/584,318

Applicant(s)

SRIVASTAVA ET AL.

Examiner

Chau Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 06/07/2005 has been entered. Claims 1-18 are presented for examination.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-18 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 29-36 of copending Application No. 10/120,175. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Although the conflicting claims are not identical, they are not patentably distinct from each other because the context of the claimed invention is similar as the context of the cited claims of the copending Application No. 10/120,175.

***Claim Rejections - 35 USC § 101***

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-18 are rejected under 35 U.S.C. 101 because an "application program" to perform the method of claims 29-36 is non-statutory as not being tangible.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims 1, 8 and 12 contain subject matter "an Internet address to which an output information request directed to said given data resource may be transmitted" and "transmitting said reformatted request to the Internet resource address", which were not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-5 and 8-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meltzer et al. (Meltzer), US Patent No. 6,542,912 and further in view of Call, US Patent No. 6,154,738.

10. As to claims 1 and 12, Meltzer discloses a method of obtaining information via the Internet from each of a plurality of diverse data resources having different characteristics which comprises, in combination, the steps of:

storing a separate service description for each given data resource in a database, said service description including (col. 4, lines 17-31: a repository (database) stores a library of logic structures, content models, and schematic maps for logic structures, and definition of documents (service description) that comprise logic structures used to build interface description):

an address to which an output information request directed to said given data resource may be transmitted (col. 4, lines 32-54, col. 10, lines 3-42, col. 11, lines 41-58: a market participant document (service description) associating contact and address information with a description of services and financial information, and these services identified by the market participant will specify the input and output documents which that participant is expected respond to and produce),

a specification of the nature of the input information to be supplied by said requesting client application (col. 3, lines 1-23, and col. 27, lines 15-40), and

a description of the nature of the output information to be returned to said requesting client application in response to said output information request (col. 3, lines 1-23, and col. 27, lines 15-40),

establishing an application program interface for accepting service requests in standard form from said requesting application programs (col. 3, lines 4-58: establishing an interface for transactions comprising a machine-readable specification of an interface which includes a definition of an input document and a definition of an output document, that are accepted and produced by transaction processes for which the node acts as an interface, and the definitions of the input and output documents comprise respective descriptions of sets of storage units such as a standard XML based document),

issuing a service request from said requesting application program to said application program interface, said service request identifying a particular resource (col. 19, lines 16-40: user input identifying a participant, service and document information generated by graphical interface), and

executing a service interface program in response to said service request, said service interface program performing the steps of:

obtaining the particular service description for said particular resource from said database (col. 19, lines 16-40: any referenced logical structures, interpretation information, document definitions and/or service definitions are retrieved from the repository in response to user input via the graphical interface),

obtaining said input information conforming to said specification contained in said particular service description from said executing application program and supplying said input information to said particular resource (col. 3, lines 4-58: establishing an interface for transactions comprising a machine-readable specification of an interface which includes a definition of an input document and a definition of an output document, that are accepted and produced by transaction processes for which the node acts as an interface, and the definitions of the input and output documents comprise respective descriptions of sets of storage units such as a standard XML based document; col. 24, line 56 – col. 25, line 5), and

routing output information provided by said particular resource in response to said output information request to said executing application program (col. 24, line 56 – col. 25, line 5).

However, Meltzer does not explicitly disclose producing an information request message that includes said input information, and transmitting said information request message to the Internet address included in said particular resource. In the same field of endeavor, Call discloses receiving Internet request messages containing all or part of a universal product code and returning the Internet address at which information about the identified product or the manufacturer of that product may be obtained via Internet (Abstract and col. 5, lines 29-42). Since Call discloses a method for communicating between manufacturer and resellers and consumers, which is similar to commercial transactions between customers and suppliers of Meltzer, it would have been obvious to

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one of ordinary skill in the art at the time the invention was made to combine the teachings of Call and Meltzer to include transmitting said reformatted request to the Internet resource address and receiving a raw response via the Internet. Call's system enables the retrieval of information about products from the source of the manufacturer and also provide low cost, worldwide and bi-directional communication between manufacturer and consumers.

11. As to claims 2 and 13, Meltzer and Call disclose wherein said step of storing a separate service description for each given data resource comprises registration means for accepting service description information in a predetermined format (Meltzer, col. 9, line 44 – col. 10, line 42: participants are able to send documents (service description) to a market marker node, at which the document is identified and routed to an appropriate participant which has registered to receive such documents as input in an XML format).

12. As to claims 3 and 14, Meltzer and Call disclose wherein said predetermined format is the Extensible Markup Language (Meltzer, col. 10, lines 3-42).

13. As to claims 4 and 15, Meltzer and Call disclose wherein said service description as expressed in Extensible Markup Language is validated against a Service Descriptor schema which specifies the content of said service description before said service description is stored in said database (Meltzer, col. 11, line 13 – col. 12, line 13).

14. As to claims 5 and 16, Meltzer and Call disclose wherein said service description as stored in said database further comprises contact information specifying a person or entity supplying the resource described in said service description (Meltzer, col. 10, lines 3-42).

15. As to claim 8, Meltzer discloses apparatus for processing a request for information from a specified resource which comprises, in combination,

a database for storing a service description for each of a plurality of different resources, said service description comprising an input processing specification, an Internet resource address, and an output processing specification (col. 4, lines 17-31 and col. 10, lines 3-42: a repository (database) stores a library of logic structures (service description) for storing an identifier of the interface and for string at least one of specifications and references to specifications of a set of one or more transactions supported by the interface, and the logic structures include input document business interface definitions (input processing specification), a network address or location (an Internet resource address), and an output document business interface definitions (output processing specification)),

an executing application program for issuing said request for information from said specified resource (col. 3, lines 1-58: establishing an interface for transactions comprising a machine-readable specification of an interface which includes a definition of an input document and a definition of an output document, that are accepted and

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produced by transaction processes for which the node acts as an interface, and the definitions of the input and output documents comprise respective descriptions of sets of storage units such as a standard XML based document), and

an interface program for receiving said request from said executing application program via a standard application program interface, said interface program including (col. 3, lines 1-58 and col. 24, line 56 – col. 25, line 5),

means for retrieving the particular service description for said specified resource from said database (col. 24, line 56 – col. 25, line 5),

means for processing input data obtained from said executing application in accordance with the input processing specification contained in said particular service description for said specified resource to produce a reformatted request (col. 24, line 56 – col. 25, line 5),

means for transmitting said reformatted request to the resource address contained in said particular service description for said specified resource (col. 24, line 56 – col. 25, line 5);

means for receiving a raw response from said specified resource in response to said reformatted request (col. 24, line 56 – col. 25, line 5),

means for processing said raw response in accordance with said output processing specification contained in said particular service description for said specified resource to produce a reformatted response (col. 24, line 56 – col. 25, line 5),  
and

means for transmitting said reformatted response to said executing application program (col. 3, lines 4-58 and col. 24, line 56 – col. 25, line 5).

However, Meltzer does not explicitly disclose transmitting said reformatted request to the Internet resource address and receiving a raw response via the Internet. In the same field of endeavor, Call discloses receiving Internet request messages containing all or part of a universal product code and returning the Internet address at which information about the identified product or the manufacturer of that product may be obtained via Internet (Abstract and col. 5, lines 29-42). Since Call discloses a method for communicating between manufacturer and resellers and consumers, which is similar to commercial transactions between customers and suppliers of Meltzer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Call and Meltzer to include transmitting said reformatted request to the Internet resource address and receiving a raw response via the Internet. Call's system enables the retrieval of information about products from the source of the manufacturer and also provide low cost, worldwide and bi-directional communication between manufacturer and consumers.

16. As to claim 9, Meltzer and Call disclose registration means for accepting descriptive data from a remote location and for processing said descriptive data to form said service description stored in said database (Meltzer, col. 19, lines 49-64).

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17. As to claim 10, Meltzer and Call disclose wherein in said input processing specification includes the designation of an input adaptor program which, when executed, performs at least some of the processing of said request to produce said reformatted request (Meltzer, col. 24, line 56 – col. 25, line 5).

18. As to claim 11, Meltzer and Call disclose wherein said output processing specification includes the designation of an output adaptor program which, when executed performs at least some of the processing of said raw response to produce said reformatted response (Meltzer, col. 24, line 56 – col. 25, line 5).

19. Claims 6-7 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meltzer and Call as discussed in claims 1-5, 8-16 above, and further in view of Walker et al. (Walker), US Patent No. 6,041,308.

20. As to claims 6 and 17, Meltzer and Call disclose limitations as discussed above. However, Meltzer and Call do not explicitly disclose wherein said service description as stored in said database further comprises test information consisting of a fixed input value and a fixed output value which enables said service interface program to perform automatic testing of the described resource by sending said fixed input value to said resource and comparing the resulting output from said resource with said fixed output value. Walker discloses a test is performed to determine if a conditional purchase offer is accepted or rejected, and if it is accepted (fixed input value), then the conditional

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purchase offer selects one accepting seller and notifies the corresponding seller (fixed output value) (col. 9, lines 17-64). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Meltzer, Call and Walker to include wherein said service description as stored in said database further comprises test information consisting of a fixed input value and a fixed output value which enables said service interface program to perform automatic testing of the described resource by sending said fixed input value to said resource and comparing the resulting output from said resource with said fixed output value in order to make the system more efficient.

21. As to claims 7 and 18, Meltzer, Call and Walker disclose wherein said service description as stored in said database further comprises security information for ensuring that a request for output information originates from an authorized source before that request is satisfied (Walker, col. 9, lines 40-52: the processing of accounting transactions between sellers and buyers can be secured in a conventional manner, for example, using well –known cryptographic techniques. It would have been obvious to one of ordinary skill in the art at the time the invention was made to include security information during the processing of transactions in order to prevent unauthorized users accessing secure content).

***Response to Arguments***

Applicant's arguments and amendments filed on 06/07/2005 have been fully considered but they are not deemed fully persuasive. Applicant's arguments with respect to claims 1, 8 and 12 have been considered but are moot in view of the new ground(s) of rejection as explained here below, necessitated by Applicant's substantial amendment (i.e., transmitting said reformatted request to the Internet resource address and means for receiving a raw response via the Internet) to the claims which significantly affected the scope thereof.

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (571) 272-4092. The Examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Heather Herndon, can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chau Nguyen  
Patent Examiner  
Art Unit 2176

*William S. Bashore*  
WILLIAM BASHORE  
PRIMARY EXAMINER  
8/22/2005